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| 09/837,632      | 04/19/2001  | Jesse Perla          | 1351829.0016        | 8089             |

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ORMISTON & MCKINNEY  
P.O. BOX 298  
802 W. BANNOCK  
SUITE 400  
BOISE, ID 83701-0298

EXAMINER

PHAN, TAM T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2144

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/837,632

Applicant(s)

PERLA ET AL.

Examiner

Tam (Jenny) Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/19/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This application has been examined. Amendment received 11/15/2004 has been entered. Claim 1 is presented for examination.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

3. This application is a continuation of PCT/CA01/00149 01/31/2001 and is a CIP of 09/471,135 12/23/1999.

4. This application claims priority of Foreign Applications: Canada 2,297,596 (01/31/2000); Canada 2,297,597 (01/31/2000); Canada 2,297,711 (01/31/2000).

5. Any new subject matter defined in the claims not previously disclosed in claimed parent applications above, is entitled to the effective filing date of 04/19/2001.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Praitis et al. (U.S. Patent Number 6,594,697), hereinafter referred to as Praitis, in view of Bridgman et al. (U.S. Patent Number 6,523,062), hereinafter referred to as Bridgman.

8. Praitis disclosed a method for generating error messages in a web based application (Figures 2-3, 8-11, Abstract), said method comprising the steps of: searching said application for a predetermined error number; retrieving an error

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message corresponding to said error number; applying said error message to a HTML script in an error form; and displaying said error form on a requesting device (Figures 2-3, 5, 8-11, column 7 line 44-column9 line 3, column 9 lines 39-51, column 11 lines 16-27, column 13 lines 22-32)

9. Praitis taught the invention substantially as claimed. However, Praitis did not expressly teach applying said error message to a style sheet in an error form.

10. Praitis suggested exploration of art and/or provided a reason to modify the method with additional features to allow the method to be practiced with other computer system configuration, including hand-held devices (column 4 lines 18-23, column 6 lines 35-47, column 14 lines 52-53).

11. Bridgman disclosed a method of applying an input message document [error message] to an Extensible Stylesheet Language style sheet in an output document [error form] to transform the document from one type to another (i.e. transforming an XML document to a WML document) when presenting the output document to handheld devices that have limited memory and storage as well as limited display space (column 1 lines 56-column 2 lines 7, column 2 lines 29-65).

12. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Praitis with the teachings of Bridgman to include the step of applying the error message [message document] to a style sheet in an output document [error form] in order to provide an efficient means of filtering output documents since style sheet described transformation from one document type to another, such as transforming XML document to WML document, which would allow

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limited display, constrained device such as hand-held devices to display the output form [error form] (Bridgman, column 1 lines 55-column 2 lines 7, column 2 lines 47-65).

13. Since all the limitations of the claimed invention were disclosed by the combination of Praitis and Bridgman, claim 1 is rejected.

14. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miksovsky et al. (U.S. Patent Number 6,526,529), hereinafter referred to as Miksovsky, in view of Hind et al. (U.S. Patent Number 6,585,778), hereinafter referred to as Hind.

15. Miksovsky disclosed a method for generating error messages in a web based application (Figures 2, 5A-5C), said method comprising the steps of: searching said application for a predetermined error number, retrieving an error message corresponding to said error number; applying said error message to a text-based format in an error form; and displaying said error form on a requesting device (Abstract, Figures 5A-6, column 5 lines 56-67, column 6 lines 1-29, column 6 line 64-column 7 line 12).

16. Miksovsky taught the invention substantially as claimed. However, Miksovsky did not expressly teach applying said error message to a style sheet in an error form.

17. Miksovsky suggested exploration of art and/or provided a reason to modify the method with additional features to enable the output documents to be displayed in limited-function, constrained hand-held devices (column 2 line 63-column 3 line 6, column 9 lines 12-20).

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18. Hind disclosed a method of applying an input document message [error message] to a style sheet in an output document [error form] (Abstract, Figures 2-4, 7, column 7 lines 19-50, column 7 line 65-column 8 line 7, column 8 lines 38-57).

19. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Miksovsky with the teachings of Hind to include the step of applying the error message [input document message] to a style sheet in an output document [error form] in order to transform the output error form into a format that would be better suited to the target clients (Hind, column 7 lines 19-33) since hand-held devices, such as cell phone and PDA, would need a document presentation that their limited function could handle (Hind, column 7 lines 34-50). A typical means of performing format translation and transformation is by applying a style sheet to the input document (Hind, column 7 lines 47-50).

20. Since all the limitations of the claimed invention were disclosed by the combination of Miksovsky and Hind, claim 1 is rejected.

### **Response to Arguments**

21. Applicant's arguments filed 11/15/2004 have been fully considered but they are not persuasive.

22. In response to applicant's argument that there is no suggestion to combine the references of Praitis and Bridgman, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

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1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Praitis disclosed "It will be understood by those skilled in the art that various other changes in the form and details may be made therein without departing from the spirit and scope of the invention" (column 14 lines 52-57) and "Those skilled in the art will appreciate that the invention may be practiced with other computer system configurations, including hand-held devices, multiprocessor systems, microprocessor based or programmable consumer electronics, network PCs, mini computers, main frame computers and the like", thus, this would motivate and/or provided a reason for one of ordinary skills in the art at the time the invention was made to explore arts to modify the method with additional features to display the error form on limited display space, constrained device such as hand-held devices.

23. In response to applicant's arguments that "Bridgman does not teach or suggest applying an error message to a style sheet in an error form", one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Praitis disclosed the error message and the error form features. Bridgman was relied upon for the style sheet transformation to enable the error form to effectively display on limited display space, constrained device such as hand-held devices.

24. In response to applicant's argument that there is no suggestion to combine the references of Miksovsky and Hind, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

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found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Miksovsky disclosed "It should be understood, however, that there is no intention to limit the invention to the specific form or forms disclosed, but on the contrary, the intention is to cover all modifications, alternative constructions, and equivalents falling within the spirit and scope of the invention" (column 9 lines 15-20) and "Moreover, those skilled in the art will appreciate that the invention may be practiced with other computer system configurations, including hand-held devices, multi-processor systems, microprocessor-based or programmable consumer electronics, network PCs, minicomputers, mainframe computers and the like" (column 2 line 63-column 3 line 1), thus, this would motivate and/or provided a reason for one of ordinary skills in the art at the time the invention was made to explore arts to modify the method with additional features in order to display the error form on limited-function, constraint hand-held devices.

25. In response to applicant's arguments that Hind does not teach or suggest applying an error message to a style sheet in an error form, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Miksovsky disclosed a method for generating error messages in a web based application (Figures 2, 5A-5C), said method comprising the steps of: searching said application for a predetermined error number, retrieving an error message corresponding to said error number; applying said error message to a text-based format in an error form; and



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displaying said error form on a requesting device (Abstract, Figures 5A-6, column 5 lines 56-67, column 6 lines 1-29, column 6 line 64-column 7 line 12) and Hind was relied upon for the style sheet transformation to enable the error form to display on limited-function, constrained hand-held devices (Hind, column 7 lines 30-50).

26. As the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious.

### ***Conclusion***

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

28. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (571) 272-3930. The examiner can normally be reached on M-F 9:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571) 272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William Cuchlinski  
SPE  
Art Unit 2144  
(571) 272-3925

tp  
March 8, 2005